

REMARKS

Reconsideration of the instant application is respectfully requested. The present amendment is responsive to the Office Action of January 9, 2009, in which claims 1, 2, 4, 5 and 29 are presently pending. Of those, claims 1, 2, 4, 5 and 29 have now been rejected under 35 U.S.C. §101 as being directed toward non-statutory subject matter. With regard to the art of record, claims 1, 2, 4, 5 and 29 remain rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 7,155,425 to Nykanen, in view of U.S. Patent 6,985,939 to Fletcher, et al., and further in view of U.S. Patent 7,155,425 to Zeng, et al. For the following reasons, however, it is respectfully submitted that the application is now in condition for allowance.

Addressing first the newly applied rejections under 35 U.S.C. §101, prompted by the recent *Bilski* decision by the Federal Circuit, claim 1 has been amended as set forth above to recite that the claimed requests (locating service details, registering a new external matching engine) are received at a data processing host. Support for this amendment is found at least in Figure 1 of the drawings and in page 16, line 15 through page 17, line 5 of the specification. Thus, the method claims as presently amended satisfy the *Bilski* criteria in that the claims are positively tied to a machine in which the UDDI method-performing registry is installed – i.e., a data processing host. Moreover, such a tie does not represent insignificant post-solution activity, because receiving requests at a data processing host are an integral step in the beginning of method itself and not simply carried out post-solution.

Accordingly, it is respectfully submitted that the method claims as now amended, overcome the outstanding §101 rejections. In addition, newly added claims 30-34 reintroduce the subject matter of the previously cancelled registry (system) claims. Since these claims recite structure from the outset, they are also statutory subject matter.

Turning now to the outstanding §103 rejections of the pending claims, the Examiner has effectively deemed the Applicants' previous amendments and accompanying arguments unpersuasive, given that the same three references of record from the previous office action (Nykanen, Fletcher, Zeng) are still applied. In summary, the Examiner's position is that the claim language emphasized by the Applicants has been afforded no patentable weight because it allegedly does not serve as limitation on the claim(s). More specifically, with respect to the following claim language:

"selecting from a plurality of external matching services an external matching service which, itself, comprises an external, published search engine independent of a search engine internal to the UDDI registry, the published search engine capable of comparing the service requirements and service capabilities through semantic cues in the UDDI request, wherein each external matching service is accessed through an interface defined in an interface tModel;"

Only the un-highlighted portion of the claim language was actually considered as limiting by the Examiner. The remaining highlighted portion of the claim language is, according to the Examiner, not functionally interrelated with useful acts, structure or properties of the claimed invention, and therefore will not serve as a limitation. However, the Applicants respectfully submit that this assertion is merely conclusory in nature since the Examiner does not explain why such language does not serve as a limitation on the claim, other than to note that claim language "is largely directed towards a description of the external search engine...".

To the contrary, the Applicants respectfully submit that a selected external matching service that is itself, an external published search engine independent of the UDDI registry's internal search engine describes a property of the selection step of the claimed method, and as such, should be given patentable weight. The same is true for the language of claim 29. Nevertheless, in order to address the Examiner's contention that optional or conditional elements do not limit the scope of the claims, both claims 1 and 29

have been amended to remove “capable of” language and instead recite the respective method steps in a positive, definitive manner. Therefore, all of the language in the claims as now amended should be afforded patentable weight.

The present §103 rejections are based entirely on the Examiner’s contention that the language at issue does not impose any limits on the scope of the claim. That is, the Examiner did not (for the sake of argument) assume that such language was limiting and then attempt to identify another reference that teaches the missing claim language absent from the combined teachings of Nykanen, Fletcher and Zeng. Therefore, since the entire language of the claims should now be given patentable weight, and since such language (as previously argued) is not taught or suggested in the combination of applied references, the Applicants respectfully submit that the §103 rejections have been addressed and overcome.

For the above stated reasons, it is respectfully submitted that the present application is now in condition for allowance. No new matter has been entered. If any fees are due with respect to this Amendment, please charge them to Deposit Account No. 50-0510 maintained by Applicants’ assignee.

Respectfully submitted,
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